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| 10/077,419      | 02/15/2002  | Charles C. Anderson  | 84114AEK            | 3527             |

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Paul A. Leipold  
Patent Legal Staff  
Eastman Kodak Company  
343 State Street  
Rochester, NY 14650-2201

EXAMINER

THOMPSON, CAMIE S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1774

DATE MAILED: 10/07/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/077,419

Applicant(s)

ANDERSON ET AL.

Examiner

Camie S Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 24-26 and 30-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-23 and 27-29, drawn to a multilayer, touch screen and display device, classified in class 428, subclass 690.
  - II. Claims 24-26 and 30-36, drawn to a method of making a multilayer, classified in class 430, subclass 273.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, a multilayer can be made by removing the partially ablated portions of the second layer prior to exposure to actinic radiation.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Arthur Kluegel on August 28, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-23 and 27-29. Applicant in replying to this Office action must make affirmation of this election. Claims 24-26

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and 30-36 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Specification*

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

***Claim Objections***

7. Claim 17 is objected to because of the following informalities: The word "polymeric" is not separated from the words "polycarboxylic" and "polysulfonic". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-8 and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Patel et al., U.S. Patent Number 6,451,505.

Patel discloses an imageable element comprising a substrate and a first layer that comprises a photosensitive composition that absorbs actinic radiation, which describes radiation in the UV, visible or both spectral ranges as per instant claims 1-4 and 20 (see column 3, lines 10-35). Also, Patel discloses a second layer and a polymeric resin material sandwiched between the first and second layer (see column 4, lines 33-47). The reference discloses that the resin can be a water insoluble resin (see column 4, lines 48-50). Patel also discloses that the photothermal converter can comprise a dye as per instant claim 6 (see column 11, lines 1-6). Polyaniline and polythiophene are disclosed in the reference as conductive polymers used in the first layer as per instant claims 7-8 (see column 11, lines 1-25). Column 12, lines 3-31 of the reference discloses a radiation absorbing compound comprising 2-hydroxybenzophenone as per instant claim 5. Column 5, lines 26-43 of the reference disclose the use of polyhydroxy and polysulfonic acids used in the multilayer as per instant claims 17-18. Copolymers of vinyl acetate used as binders

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are disclosed in column 9, lines 4-12 as per instant claim 19. Further, a transparent film can be on the backside of the first layer as per instant claim 20 (see column 12, lines 26-31). The term "capable" does not add a positive recitation to the claim. Instant claim 20 does not have a clear distinction as to whether or not the first layer absorbs actinic radiation.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 9, 16 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel et al., U.S. Patent Number 6,451,505 in view of Heuer et al., U.S. Patent Number 6,287,713.

Patel discloses an imageable element comprising a substrate and a first layer that comprises a photosensitive composition that absorbs actinic radiation, which describes radiation in the UV, visible or both spectral ranges as per instant claims 1 and 20 (see column 3, lines 10-35). Also, Patel discloses a second layer and a polymeric resin material sandwiched between the first and second layer (see column 4, lines 33-47). Patel also discloses that the photothermal converter can comprise a dye as per instant claim 6 (see column 11, lines 1-6). Further, a transparent film can be on the backside of the first layer as per instant claim 20 (see column 12, lines 26-31). Patel does not disclose that the conductive polymer is a polyethylenedioxythiophene as per instant claim 9. Heuer teaches an electroluminescent assembly such as a multilayer in a light emitting diode as per instant claims 21-23 (see column 1, lines 4-68). Heuer teaches a

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polyethylenedioxythiophene with substituted or unsubstituted groups as described in claim 16 (see column 2, 16-51). The polyethylenedioxythiophene compound provides high light flux as disclosed by Heuer in column 2, lines 3-4. Therefore, it would have been obvious to one of ordinary skill in the art to include substituted or unsubstituted polyethylenedioxythiophene in place of the conductive polymer as in instant claim 16 in order to obtain greater light emission.

11. Claims 1, 10-15 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel et al., U.S. Patent Number 6,451,505 in view Malhorta, U.S. Patent Number 5,984,468.

Patel discloses an imageable element comprising a substrate and a first layer that comprises a photosensitive composition that absorbs actinic radiation, which describes radiation in the UV, visible or both spectral ranges as per instant claims 1 and 20 (see column 3, lines 10-35). Also, Patel discloses a second layer and a polymeric resin material sandwiched between the first and second layer (see column 4, lines 33-47). The reference discloses that the resin can be a water insoluble resin (see column 4, lines 48-50). Further, a transparent film can be on the backside of the first layer as per instant claim 20 (see column 12, lines 26-31). The Patel reference does not disclose that the resin sandwiched between the first and second layer comprises microspheres as per instant claim 10. Malhorta teaches a multilayer where microspheres are located between the first and second layers (see column 5, lines 35-37). The Malhorta reference teaches a multilayer that is used as an imageable element. Additionally, Malhorta teaches that the microspheres can be hollow or solid and can be a cross-lined polymer such a vinylidene chloride-acrylonitrile as per instant claims 13-15 (see column 5, lines 35-64). Malhorta discloses that the microspheres can be embedded into one or both surfaces of the substrate and

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the first and second layers by size press treatment as per instant claims 27-29 (see column 16, lines 4-33). The addition of embedded microspheres improves properties of the layer such as the coefficient of friction. Therefore, it would have been obvious to one of ordinary skill in the art to have embedded microspheres in the polymeric layers and substrate in order to increase the surface properties of the multilayer.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Camie S. Thompson whose telephone number is (703) 305-4488. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly, can be reached at (703) 308-0449. The fax phone numbers for the Group are (703) 872-9310 {before finals} and (703) 872-9311 {after finals}.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

